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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,533	02/07/2001	Campbell Rogers	MIT 7501 CON	2030

23579 7590 01/13/2004

PATREA L. PABST
HOLLAND & KNIGHT LLP
SUITE 2000, ONE ATLANTIC CENTER
1201 WEST PEACHTREE STREET, N.E.
ATLANTA, GA 30309-3400

EXAMINER

GAMBEL, PHILLIP

ART UNIT	PAPER NUMBER
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1644

14

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,533

Applicant(s)

ROGERS ET AL.

Examiner

Phillip Gambel

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003. *SEE OFFICE ACTION.*
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: COPY OF OFFICE ACTION
MAILED 10/30/03

Serial No. 09/776533
Art Unit 1644

DETAILED ACTION

1. Upon a request for reconsideration of the outstanding Linking Claim Restriction set forth in the Office Action, mailed 10/30/03, by applicant's representative Patrea Pabst to Technology Center Director Jasmine Chambers on 11/25/03, the following Supplemental Office Action is set forth.

Applicant's representative requested an Election of Species, as set forth in parent application USSN 08/823,999, rather than the outstanding Linking Claim Restriction set forth in the Office Action, mailed 10/30/03.

In the interest of consumer service and consistency with the Election of Species in the parent application USSN 08/823,999, an Election of Species is set forth in the instant application.

2. This application contains claims directed to the following patentably distinct species of the claimed Invention: wherein the compound which target distinct adhesion molecule receptors and ligands in methods of inhibiting stenosis or restenosis is selected from the following:

- A. Mac-1-specific antibodies,
- B. LFA-1-specific antibodies,
- C. p150,95-specific antibodies,
- D. CD11d/CD18-specific antibodies,
- E. ICAM-specific antibodies,
- F. fibrinogen-specific antibodies,
- G. C3bi-specific antibodies,
- H. factor X -specific antibodies,
- I. ICAM-2-specific antibodies,
- J. ICAM-3-specific antibodies,
- K. ICAM-1,
- L. fibrinogen,
- M. C3bi,
- N. factor X,
- O. ICAM-2, or
- P. ICAM-3.

The claimed methods employ various adhesion molecule receptors and/or ligands or specific antibodies thereto are distinct because their structures, physicochemical properties and modes of action are different, which require non-coextensive searches. These molecules are different with respect to biochemical properties; including primary, secondary and tertiary structure. These molecules do not share a substantial structural feature essential to a common utility. Therefore, they are patentably distinct.

For convenience and given the recitation of instant claim 8, the species are set forth as they read on adhesion molecules or adhesion molecule-specific antibodies only in this Office Action.

Further, it is noted the instant specification discloses a number of patentably distinct agents (e.g. pages 7-19, Composition), which may be subject to further election of species (e.g. peptides, peptidomimetic, antisense oligonucleotides and ribozymes as they read on a adhesion molecule receptor or ligand)

The Species are set forth below appear to read on the claims as currently recited, but may be subject to further Species Election depending on the claimed recitation.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic, for example.

3. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Serial No. 09/776533
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6. Since applicant has received an action on the merits for the originally presented invention with respect to antibodies that bind Mac-1, this invention has been constructively elected by original presentation for prosecution on the merits.

As indicated in the previous Office Action, mailed 10/30/03, the claims are ambiguous in their recitation with respect to the antecedent basis of claimed limitations and the intended metes and bounds of the claims.

Upon reconsideration given the elected invention of anti-Mac-1 antibodies, it appears that claim 9 should have been considered a non-elected claim.

Accordingly, claim 9 has been withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

7. A copy of the outstanding Office action, mailed 10/30/03 is provided herein for applicant's convenience.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (571) 272-0844. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 872-9306.

Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
January 12, 2004

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- G. C3bi-specific antibodies,
- H. factor X -specific antibodies,
- I. ICAM-2-specific antibodies,
- J. ICAM-3-specific antibodies,
- K. ICAM-1,
- L. fibrinogen,
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Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
January 12, 2004